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EXAMINER				
WANG, CHANG YU				
ART UNIT		PAPER NUMBER		
1649				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/785,351

**Applicant(s)**

KORNECKI ET AL.

**Examiner**

CHANG-YU WANG

**Art Unit**

1649

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 November 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 18 and 21-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 18 and 21-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB-08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**  
**RESPONSE TO AMENDMENT**

***Status of Application/Amendments/claims***

1. Applicant's amendment filed 11/5/09 is acknowledged. Claims 1-17, 19-20 and 26-31 are cancelled. Claims 18 and 22-25 are amended. Claims 18 and 21-25 are pending in this application and under examination in this office action.
2. Any objection or rejection of record, which is not expressly repeated in this office action has been overcome by Applicant's response.
3. Applicant's arguments filed on 11/5/09 have been fully considered but they are not deemed to be persuasive for the reasons set forth below.

***Claim Rejections/Objections Withdrawn***

4. The objection to claims 24 and 25 is withdrawn in response to Applicant's amendment to the claims.

The rejection of claims 23-31 under 35 U.S.C. 112, second paragraph, as being indefinite is withdrawn in response to Applicant's amendment to the claims and cancellation of claims 26-31.

The rejection of claims 26-31 under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement is withdrawn in response to Applicant's amendment to the claims and cancellation of claims 26-31.

The rejection of claims 18 and 21-31 under 35 U.S.C. 102(e) as being anticipated by US Patent No. 7166703 (Goddard et al., issued Jan 23, 2007) is withdrawn in response to Applicant's cancellation of claims 26 and 31 and Applicant's arguments on p. 6 of the response because the priority of the instant application is Sept 16, 1998, which predates the priority of US7166703 (Oct 7, 1998).

***Claim Rejections/Objections Maintained***

In view of the amendment filed on 11/5/09, the following rejections are maintained.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18 and 21-25 stand rejected under 35 U.S.C. 102(b) as being anticipated by GenBank accession number AA101561, October 1996. The rejection is maintained for the reasons made of record.

Claims 18 and 21-25 as amended are drawn to DNA oligomers capable of hybridizing in full length under high stringency conditions to the full length of a nucleic acid molecule having/consisting of a nucleotide sequence selected from the group consisting of SEQ ID NO:1, nucleotides 16-912 of SEQ ID NO:1 and nucleotides 97-912 of SEQ ID NO:1 wherein the high stringency hybridization conditions are overnight

hybridization at about 68°C in 6XSSC and a wash in 6X SSC at room temperature, followed by a wash at 68°C first in 6XSSC and then in 0.6XSSC, wherein the nucleotide sequence of SEQ ID NO:1 or nucleotides 97-912 of SEQ ID NO:1 encodes an amino acid sequence selected from the group consisting of SEQ ID NO:3 and amino acid residues 28-299 of SEQ ID NO:3.

On p. 6 of the response, Applicant argues that GenBank reference does not teach a DNA oligomer capable of hybridizing in full length to the full length of nucleic acid molecules recited in claims 18, 21, 22 and all claims depending therefrom of the present application because instant SEQ ID NO:1 is 99.2% identical to the molecule in the GenBank reference. Applicant's arguments have been fully considered but it is not persuasive.

In contrast to Applicant's arguments, the DNA molecule with the GenBank accession no. AA101561 meets the limitation of the DNA oligomer recited in amended claims 18, 21, 22 and all claims depending therefrom of the present application. As previously made of record, first, the DNA oligomers recited in instant claims 18, 21 and 22 are not limited to a particular size, which can be any length or size as long as they can hybridize to a nucleotide sequence of SEQ ID NO:1, nucleotides 16-912 or 97-912 of SEQ ID NO:1. In addition, the recitation "a DNA oligomer capable of hybridizing in full-length under high stringency conditions to the full length of a DNA molecule having or consisting of a nucleic acid sequence selected from the group consisting of SEQ ID NO:1, nucleotides 16-912 or nucleotides of 97-912 of SEQ ID NO:1" encompasses any fragments with different lengths derived from the sequence of SEQ ID NO:1,

nucleotides 16-912 or 97-912 of SEQ ID NO:1. Thus, a DNA with a short sequence derived from SEQ ID NO:1, nucleotides 16-912 or 97-912 of SEQ ID NO:1 can hybridize in full-length to any fragments derived from SEQ ID NO:1, nucleotides 16-912 or 97-912 of SEQ ID NO:1.

The DNA molecule of AA101561 is 99.2% identical to the sequence of the instant SEQ ID NO:2 over a region of 377 bases and the instant SEQ ID NO:2 is 74.5% identical to the whole molecule of instant SEQ ID NO:1 and with 99.1% local similarity. Thus, the DNA fragment (oligomers) of AA101561 is capable of hybridizing to a DNA molecule having or consisting of a nucleotide sequence (fragments) of SEQ ID NO:1, nucleotides 16-912 or 97-912 of SEQ ID NO:1 with high stringency conditions as recited in instant claims 18, 21 and 22 or wherein the nucleotide sequence selected from the group consisting of SEQ ID NO:1 and 16-912 of SEQ ID NO:1 encodes an amino acid sequence selected from the group consisting of SEQ ID NO:3 and amino acid sequence 28-299 of SEQ ID NO:3.

Third, the instant claimed DNA oligomer "capable of hybridizing in full-length....." is a product by process. If the product set forth in a product-by-process claim appears to be the same as, or an obvious variant of a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. See *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983) and *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). See also MPEP § 2113. Note that

[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985).

Accordingly, the rejection of claims 18 and 21-25 under 35 U.S.C. 102(b) for being anticipated by GenBank accession number AA101561 (October 1996) is maintained.

***Conclusion***

6. NO CLAIM IS ALLOWED.

**7. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

8. Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Papers relating to this application may be submitted to Technology Center 1600, Group 1649 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1600 is (571) 273-8300.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chang-Yu Wang whose telephone number is (571) 272-4521. The examiner can normally be reached on Monday-Thursday from 8:30 AM to 6:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey Stucker, can be reached at (571) 272-0911.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/CYW/  
Chang-Yu Wang, Ph.D.  
January 8, 2010

/Christine J Saoud/  
Primary Examiner, Art Unit 1647